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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,629	06/19/2001	Peter H. St. George-Hyslop	1034/1J800US1	3866

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EXAMINER	
WOITACH, JOSEPH T	

ART UNIT	PAPER NUMBER
1632	

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/884,629	Applicant(s) ST. GEORGE-HYSLOP ET AL.	
	Examiner Joseph T. Woitach	Art Unit 1632	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires *4* months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: *3*.
   Claim(s) rejected: *1,2,4-7 and 24-28*.
   Claim(s) withdrawn from consideration: *8-23*.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: It is noted that for a proper response to the final rejection, claims drawn .

Joe Woitach
AUG 3 2

Continuation of 5. Applicant's reply has overcome the following rejection(s):
Applicants arguments that Sommer et al. do not specifically teach the APP695 polypeptide in conjunction with the three specific mutations is found convincing. While Sommer et al. generally contemplate APP sequences, they do not specifically teach the use of APP695.

Continuation of 11. does NOT place the application in condition for allowance because:
Applicants argue that Hsiao et al. does not anticipate the claims because they do not teach the use of APP695. In addition, it is argued that the instant specification provides evidence that the claimed combination of AP695 and the three mutations provide an unexpected result not disclosed in Hsiao et al. Applciant's arguments have been fully considered, but not found persuasive. Review of the teachings of Hsiao et al. clearly indicates that the use of APP695 was contemplated in conjunction with the various AP mutations encompassed by the instant claims. Review of figures 1 and 2 detailing the cDNa used (figure 1) and the known APP mutations (figure 2) and the working examples clearly demonstrate Hsiao et al. used AP695. Moreover, as noted in the specification, the specifc combination of the three mutations were reduced to practice in the prior art , albeit with a different form of APP(page 11). While the instantly claimed transgenic animal was not reduced to practice by Hsioa et al., this does not overcome the fact that Hsiao et al. provide the necessary teachings to generate the claimed transgenic animal. With respect to arguments regarding the unexpected results, the MPEP indicates that unexpected results can not overcome anticipation in a rejection made under 35 USC 102. It is noted that without the reduction to practice and the unpredictability of the art of transgenics, the specific outcome/phenotype can not be predicted precisely, however in view of the art of Alzheimer's Disease as a whole, there would be a general expectation that greater amounts of alterations associated with the disease would result in a more dramatic phenotype. Moreover, the unexpected phenotype is only demonstrated when expression is affected by one promoter and only in the mouse. In this case, consistant with Applicants remarks concerning the art of transgenics, the unexpected results would not extend to the use of any promoter and expression in any non-human mammal encompassed by the instant claims.